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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/363,499	07/29/1999	DAVID B. SUTTON	9204-000001	8198

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HARNESS DICKEY AND PIERCE PLC
P O BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/363,499

Applicant(s)

SUTTON ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,25-28 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,25-28 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This communication is in response to amendment filed 2/25/2005.

Response to Amendment

2. Claims 23, 25 and 26 have been amended. Claim 24 is canceled. Claims 23, 25-28 and 32 are currently pending.

Response to Arguments

3. Rejection of claims under 35 U.S.C. 101 (claims not within technological art) has been withdrawn.

4. applicant's assertion that the specification as originally filed supports claim limitation of the purchase card "embossed with a non-personalized cardholder name" is not persuasive.

p. 11 the disclosure recites: "...each purchasing card may have the same or a different name listed on the card. When the consumer is prompted by the retailer's application 37 to provide a name, they simply insert the name, for example the name of the purchasing intermediary or "John Smith" as provided on the card. The consumer will also be prompted to provide the credit account number and the expiration date associated with the purchasing card."

There is no teaching or definition of "non-personalized card holder name" provided in this or any other part of the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23, 25-28 and 32 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure fails to provide written description for the purchase card which is "embossed with a non-personalized cardholder name". The disclosure fails to define what the term "non-personalized cardholder name" means.

7. In analyzing the claims, in view of this deficiency, the examiner has interpreted that any name other than the official name of the cardholder engraved on a card is a non-personalized cardholder name.

Note that claim 32 is similarly analyzed as not teaching the critical limitation of the "non-personalized card holder name" in the disclosure.

Claim Rejections - 35 USC § 103

8. Claims 23, 25-28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over article, Banks Enter A New Debit Market, And AmEx Has Its Foot In The Door, Debit Card News, v 4,

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n 11, November 30, 1998 (hereafter Debit Card News) and further in view of Abcede (Plastic Payment storm prepares to touch down), NPN v89n1 pp 26-34 January 1997 (Abcede) and further in view of 1st USA Going to Dogs--with Kennel Club Visa, American Banker, v CLXI, n 52, p 16, March 18, 1996 (1st USA).

As per claim 23, Debit Card News teaches a method of transacting a purchase, comprising:

acquiring a purchase card from a purchase card provider, where the purchase card is a bearer instrument having an associated account number, but does not identify the person who acquired the purchase card; (refer to Prepaid gift cards p. 2, purchase card is a gift card issued by AmEx and inherently does not identify the purchaser of the gift card, see p. 2 bottom paragraph "cardholders may purchase and send to anyone they want"))

providing purchase transactional information by a purchaser, including the account number associated with the purchase card, to a retailer, the retailer being different from the purchase card provider;

(see p. 2 the AmEx gift card is processed by charging merchants (different from AmEx who is the purchase card provider), inherently the purchase transactional

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information by a purchaser (who uses the gift card) is provided to the merchants);

transacting a purchase with the retailer based on the account number associated with the purchase card ,

(AmEx offers the prepaid gift card which can be used as cash) .

AmEx fails to teach that the purchaser is not required to provide any identifying information, including a personal identification number (PIN) to conduct the transaction. However Abcede, in the same field of endeavor teaches a method of transacting a purchase using a purchase card wherein the purchaser is not required to provide any identifying information including the PIN. (see p. 5 of Abcede)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide for transacting a purchase without requiring a PIN or other personal information as per claim because this would facilitate payment of small amount purchases without the need for credit card or cash and which would expedite the transaction at the point of sale.

AmEx and Abcede references combined fail to teach that the

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Purchase card is embossed with a non-personalized cardholder name and that the account number and the non-personalized cardholder name are provided to a retailer.

However 1st USA, in the same field of endeavor teaches a method of transacting a purchase using a purchase card wherein the purchase card is embossed with a non-personalized cardholder name (see "their pet's name embossed on the card"). When such card is provided to a retailer both the account number of the card and the non-personalized name are also provided since the later is engraved on the card.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have a non-personalized cardholder name embossed on the card because non-personalized cardholder name embossed on a card would provide an attractive marketing option for targeting at least the consumers who own pets and would like to carry their names on the card as expression of their love for their pet.

The cited references of AmEx, Abcede and However 1st USA fail to explicitly disclose the process step of activating the card over a network as per claim 23.

Official Notice is taken that activating a purchasing card by contacting the purchase card provider over a network using a software-implemented application using the contact information

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for purchase card provider provided on the purchase card is old and well known in electronic commerce.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to activate the purchase card as per the activating step because it would protect the cardholder from unauthorized use of the card until he or she is ready to use the card for a purchase.

Claim 25. The cited prior art fails to teach that the non-personalized cardholder name is further defined as a name for the purchase card provider.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The acquiring, providing, activating and transacting steps do not depend on the type or nature of the non-personalized name embossed on the card. These steps would be performed the same regardless of the data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to acquire card with card with any type of name (including the name being the name of the purchase card provider) on it because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 26. The method of Claim 23 wherein the step of acquiring a purchase card further comprises purchasing the purchase card from a retail establishment, where the purchase card is provided to the retail establishment by the purchase card provider.

(see p. 2 AmEx provides the cards through Chanel and Tower who have set minimums for purchasing the cards)

Claim 27. The method of Claim 26 wherein the purchase card is provided by the purchase card provider to the retail establishment on a consignment basis.

(p. 2 see pricing structure)

Claim 28. The method of Claim 26 wherein the purchase card having a purchase limit equal to an amount paid for the

purchase card less a service fee assessed by the purchase card provider.

(see p.3 "The offline, signature based cards...")

Regarding claim 32 Debit Card News in combination with Abcede teaches all limitations of claim 32 as analyzed in claims 23.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jagdish N. Patel". The signature is written in a cursive, flowing style.

Jagdish N. Patel

(Primary Examiner, AU 3624)

3/8/05